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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,215	06/21/2001	Chad A. Stevens	10010428-1	8409

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EXAMINER

HUFFMAN, JULIAN D

ART UNIT PAPER NUMBER

2853

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	09/888,215	Applicant(s)	STEVENS, CHAD A.
Examiner	Julian D. Huffman	Art Unit	2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09 September 2002 .

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-25 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 21 June 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____ .

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) Interview Summary (PTO-413) Paper No(s) _____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 7, 10, 11 and 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 7, 10 and 11, the step of applying the sticker is not a step of making the sticker.

In claims 16-19, at least one blank sheet of an electrostatic print medium is claimed and additionally it is claimed that a charge is deposited after said sticker print medium has been printed with an image. The term said sticker print medium refers back to the blank sheet and thus it is not clear as to how a blank sheet may also be printed upon.

Additionally in claim 16, line 5, it is respectfully suggested that the word "and" be changed to "an" and at line 6, it is respectfully suggested that the word "stick" be changed to "sticker".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2853

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 5, 6, 7, 10-14 and 20-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Floegel et al. (U.S. 6,284,339 B1).

With regards to claims 1, 5-7, 10 and 11, Floegel et al. disclose a method of making a user-customized electrostatic sticker, said method comprising:

printing a user-selected image on sticker print medium (column 1, lines 13-16), said sticker print medium being of a non-conductive material on which an electrostatic charge can be maintained such that said sticker print medium functions as an electrostatic sticker (column 1, lines 56-58 and column 2, lines 30-32);

said method further comprising providing an electrostatic charge on said sticker print medium prior to said printing (column 3, lines 11-14);

wherein the sticker further comprises a protective backing (element 14);

the method further comprising removing said protective backing and applying said sticker such that the side bearing the charge is in contact with a surface to which the sticker is applied (column 4, lines 39-40).

With regards to claims 12-14, Floegel et al. disclose an electrostatic sticker print medium for use with a printer, said sticker print medium comprising:

a blank sheet of electrostatic print medium (element 12);

an electrostatic charge deposited on a side of said sticker print medium (column 3, lines 11-15);

a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium (element 14);

wherein said sticker print medium is made of vinyl (column 4, lines 61-62); and

wherein said sticker print medium is transparent (column 1, lines 29-35).

With regards to claims 20 and 21, Floegel et al. disclose a system for producing user-customized electrostatic stickers, said system comprising:

a host computer for generating a user selected image;

a printer connected to said host computer for receiving print data corresponding to said user-selected image (column 1, lines 12-18); and

a sticker print medium, comprising an electrostatic charge (element 12), on which said user selected image is printed with said printer to produce said user customized sticker (title);

wherein said printer is an inkjet printer (column 2, lines 19-21 and 64-66).

With regards to claims 22-24, Floegel et al. disclose a method of producing a customized electrostatic sticker, said method comprising:

placing a user-selected image on a host computer that is connected to a printer (column 1, lines 12-18);

supplying a sticker print medium (element 12) to said printer, said sticker print medium comprising an electrostatic charge maintained on a surface of said print

Art Unit: 2853

medium by a protective cover (element 14) disposed over said surface of said print medium; and

driving said printer with said host computer to print said user-selected image on a sheet of said sticker print medium;

generating said user-selected image using application software on said host computer (column 1, lines 12-18);

wherein said printer is an inkjet printer (column 2, lines 19-21 and 64-66).

5. Claims 1, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Cooledge et al. (U.S. 5,258,214).

Cooledge et al. discloses a method of making a user-customized electrostatic sticker, said method comprising:

printing a user-selected image on sticker print medium, said sticker print medium being of a non-conductive material on which an electrostatic charge can be maintained such that said sticker print medium functions as an electrostatic sticker (column 3, lines 1-7);

depositing an electrostatic charge on said sticker print medium with a charge donor after said printing of said user selected image (column 3, line 65-column 4, line 4) such that a side of said sticker bearing said electrostatic charge is in contact with a surface to which said sticker is applied (fig. 3, column 4, lines 13-17, 43-47 and 55-60); and

perforating one or more sections of said sticker print medium (column 4, lines 7-9).

6. Claims 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Longtin (U.S. 5,334,431).

Longtin discloses an electrostatic print medium for use with a printer, said sticker print medium comprising:

a blank sheet of electrostatic print medium (the sticker was inherently blank before it was printed upon);

an electrostatic charge deposited on a side of said sticker print medium (column 3, lines 6-9); and

a protective backing over said electrostatic charge (fig. 1, 20);

wherein the sticker is transparent vinyl (column 3, lines 15-16);

wherein the sheet is perforated to define a plurality sticker panes (fig. 1).

7. Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Rubino (U.S. 4,992,121).

Rubino discloses a method comprising providing an electrostatic sticker kit, said providing an electrostatic sticker kit containing at least one blank sheet of an electrostatic sticker medium and a charge donor, other than said sticker medium, for depositing an electrostatic charge on either side of said sticker medium (abstract).

Art Unit: 2853

Further the sticker medium is capable of use in a printing device and was used in such a device to produce a decorative image thereon.

8. Claim 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Chamberlain.

Chamberlain discloses an electrostatic sticker kit comprising:
at least one blank sheet of an electrostatic sticker print medium (column 1, lines 50-54, the sticker was blank before it was printed on); and
a charge donor other than said sticker print medium for depositing an electrostatic charge on either side of said sticker print medium after said sticker print medium has been printed with an image (column 1, line 55-column 2, line 7);
wherein said at least one blank sheet of sticker print medium and said charge donor are associated together in said kit (the sticker and the charge donor could be considered part of a kit which allows a sticker to be reliably attached to a structure);
wherein said sticker print medium is made of vinyl (column 1, lines 21-22, Koroseal is one of the most popular forms of vinyl);
wherein said sheet of print medium is perforated to define a plurality of sticker panes (column 2, lines 45-52).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2853

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floegel et al. as applied to claim 1 above and further in view of Suzuki et al. (U.S. 4,882,621).

Floegel et al. disclose everything claimed with the exception of reversing the image when printing it.

Suzuki et al. discloses a printing device which uses a mode setting switch (16) to enable a mirror image converting circuit (4) to perform a mirror image conversion on data from a host apparatus when transparencies are used as the recording medium, such that the image may be viewed normally after printing (column 2, lines 43-47 and column 3, lines 36-50).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Suzuki et al. into the host computer of Floegel et al. The reason for performing the modification would have been to enable image data to appear in the proper orientation when printing on a transparent media.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Floegel et al. in view of Suzuki et al. as applied to claim 2 above, and further in view of Naik et al. (U.S. 5,579,446).

Art Unit: 2853

Floegel et al. as modified do not disclose the host computer with a printer driver performing the reversing operation of the image.

However, Naik et al. discloses a host computer which performs image processing, then sends the processed image to the printer through a printer driver (fig. 1, column 5, lines 34-41).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Floegel et al. as modified to perform the processing using a printer driver of the host computer. The reason for performing the modification would have been to reduce the cost and complexity of the printing apparatus by performing computations using the host computer.

12. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Floegel et al. as applied to claim 12 above, and further in view of Chamberlain.

Floegel et al. disclose everything claimed with the exception of perforating the sheet.

Chamberlain discloses this (column 2, lines 45-52).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form perforation on the sheet of Floegel et al. The reason for performing the modification would have been to facilitate removal of the units from a sheet.

Response to Arguments

Art Unit: 2853

13. Applicant's argument with respect to claims 1, 8, 9 and 11 has been considered but is not deemed persuasive since the user who prints on the sticker in the factory selects the image to be printed thereon.

Applicant's argument with respect to claims 12-15 that Longtin provides no teaching or suggestion that the release liner is applied to the print medium stickers before the stickers are printed is not persuasive since Longtin provides no evidence that the sheet is printed on before applying the backing. Applicant's statement that Longtin does not disclose this feature is a mere allegation that is not supported by evidence.

Applicant's additional arguments have been considered but are moot in view of the new grounds of rejection.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian D. Huffman whose telephone number is (703) 308-6556. The examiner can normally be reached on Monday through Friday from 9:30 a.m. to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow, can be reached at (703) 308-3126. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722. Faxes requiring the immediate attention of the examiner may be sent directly to the examiner at (703) 746-4386. Note that this number will not automatically send a confirmation that the fax was received.

Art Unit: 2853

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



JH

18 November 2002



CRAIG HALLACHER
PRIMARY EXAMINER